

Serial No.: 0991635  
Attorney Docket No.: 1003464-1REMARKS

In response to the Office Action dated November 17, 2004, claims 1, 4-8, 17 and 20-24 have been amended. Also, claims 9-16 and 25-32 have been withdrawn from consideration. Claims 1-8 and 17-24 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

At page 2 items 3-7 of the Office Action, the Examiner indicated that an election of the application, as amended, was requested. The Applicant's agent to elect Group I without traverse. The Applicant's agent would like to affirm the election of group one, claims 1-8 and 17-24, without traverse of group one.

Accordingly, claims 9-16 and 25-32 are withdrawn from consideration.

The Office Action rejected claims 1-8 and 20-24 under 35 U.S.C. § 112, second paragraph.

In response, the Applicants have amended the claims as suggested by the Examiner to overcome these rejections.

Claims 1-3, 5-8, 17-19 and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shima (U.S. Patent Publication 20030035144A1). In addition, claims 4 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shima in view of "Basics of Server-Side JavaScript, Chapter 4", (referred to by the Examiner as SSJ).

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

Claim 1 of the Applicant's invention recites in part "... passing a named tag element for the desired portion into the desired portion of the web page, wherein the named tag element is identified with an identification attribute predefined with a unique name for each desired portion of the web page..." Claim 17 recites in part "... a named tag unit of the print function that is arranged to surround HTML that defines the desired portion of the web page and that is coupled to the PrintNow mechanism, for passing a tagged element for the desired portion into another web page, wherein the named tag element is identified with an identification attribute predefined with a unique name for each desired portion of the web page..."

In contrast, none of the cited references, in combination or alone, disclose, teach or suggest all of the elements of the claimed invention. Namely, Shima merely discloses a network printer for printing edited contents on a network and for printing contents on the

network, while SSJ simply discloses the use of javascripts. Although Shima discloses selectively printing certain sections of HTML web pages, Shima does not disclose the Applicant's passing a named tag element for the desired portion into the desired portion of the web page and the tag element being identified with a unique name for each desired portion of the web page. Instead, Shima explicitly states that the section between the tags specifying rules lines "<HR>" is identified. The tags and the tag location are extracted as location information and stored in the storage 46 together with the corresponding URL in the storage 46 (see Paragraph [0045] of Shima). Thus, Shima merely extracts tags from the web page, thus Shima does not pass a named tag with a unique name to the web page, like the Applicant's unique, non-claimed invention.

Thus, the combination of Shima with SSJ does not disclose, teach or suggest the Applicant's claimed "...passing a named tag element for the desired portion into the desired portion of the web page, wherein the named tag element is identified with an identification attribute predefined with a unique name for each desired portion of the web page...." of claim 1 or "...a named tag unit of the print function that is arranged to surround HTML that defines the desired portion of the web page and that is coupled to the PrintNow mechanism, for passing a tagged element for the desired portion into another web page, wherein the named tag element is identified with an identification attribute predefined with a unique name for each desired portion of the web page..." of claim 17. As such, since the combination of Shima with SSJ are missing the above elements, they cannot render the claims obvious, and therefore, no prima facie case of obviousness exists. In *Re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987). In *Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.

With regard to the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).


Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the

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Applicant kindly requests the Examiner to telephone the Applicants' attorney at (818) 885-1575. Please note that all mail correspondence should continue to be directed to:

Hewlett Packard Company  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

Respectfully submitted,  
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Edmond A. DeFrank  
Reg. No. 37,814  
Attorney for Applicants  
(818) 885-1575 TEL  
(818) 885-5750 FAX